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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT LYNN, SHANE BRADY, and JOHN LINDEN ¹

Appeal 2015-004546
Application 10/915,975
Technology Center 2600

Before KRISTEN L. DROESCH, JOHN A. EVANS, and SCOTT E. BAIN,
Administrative Patent Judges.

DROESCH, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek review under 35 U.S.C. § 134(a) from the Final Rejection of claims 1, 3, 4, 8–11, 13–16, 18, 19, 22–26, 28–31, 33, 34, 38–41, 43–47, 49, 50, 53, 55, 58–61, 63, 66–69, 71, 72, 74–77, and 79–96.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellants indicate the real party-in-interest is Adknowledge, Inc. Br. 3.

² Claims 2, 5–7, 12, 17, 20, 21, 27, 32, 35–37, 42, 48, 51, 52, 54, 56, 57, 62, 64, 65, 70, 73, and 78 have been cancelled.

BACKGROUND

The disclosed invention relates to generating time relevant dynamic content for electronic mail, i.e., e-mail. *See* Spec. 2–7; Abstract.

Representative claims 1 and 55, reproduced from the Claims Appendix of the Appeal Brief, read as follows (disputed limitations in *italics*):

1. A method for providing, via a network, time-relevant content into electronic communications comprising:
 - sending an electronic communication to a recipient over the network, the electronic communication including a content request, that is automatically transmitted from the recipient over the network when the electronic communication is opened;
 - receiving the content request that was automatically transmitted from the recipient when the recipient opened the electronic communication;
 - responding to the content request including generating content for the opened electronic communication by applying at least one predetermined rule or policy to the content request at the time the content request is received, whereby the content may be different each time the electronic communication is opened;
 - converting the content into an image associated with the content; and*
 - providing the image associated with the content to the opened electronic communication,
 - wherein the content request includes at least one keyword, and generating the content for the opened electronic communication includes extracting the at least one keyword from the content request, and obtaining the content for the opened electronic communication based on the at least one keyword.*

55. A system for providing content to electronic communications over a network comprising:
 - a) a first server linked to the network configured for procuring content for electronic communications by:

sending an electronic communication to a recipient over the network, the electronic communication including a content request that includes at least one keyword and is automatically transmitted from the recipient over the network when the electronic communication is opened;

receiving the content request, that was automatically transmitted from the recipient of the electronic communication when the recipient opened the electronic communication;

generating content for the opened electronic communication, by processes including:

responding to the receipt of the content request;

and

obtaining the content from at least one source based on the at least one keyword obtained from the content request, the content including data, that upon being activated, provides a browsing application associated with the opened electronic communication, with at least one uniform resource locator for at least one target web site, whereby the content may be different each time the electronic communication is opened; and

b) *an imaging server in data communication with the first server configured for providing the content for the electronic communications by: converting the content into an image associated with the content and providing the image associated with the content including the activatable data for the opened electronic communication, the image including an activatable portion from which the activatable data is activated.*

REJECTIONS

Claims 1, 3, 4, 8–11, 13–16, 18, 19, 22–26, 28–31, 33, 34, 38–41, 43–47, 49, 50, 53, 55, 58–61, 63, 66–69, 71, 72, 74–77, and 79–93 stand rejected under the non-statutory doctrine of obviousness-type double patenting as unpatentable over Application 12/647,749, now US 8,626,845 B2. *See* Final Act. 2–6.

Claims 1, 3, 4, 8–11, 13–16, 18, 19, 22–26, 28–31, 33, 34, 38–41, 43–47, 49, 50, 53, 69, 66–69, 79–88, and 90–96 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sharma (US 2002/0087631 A1; July 4, 2002), Tucciarone et al. (US 2004/0122730 A1; June 24, 2004) (“Tucciarone”), and Matsuura et al. (US 7,346,659 B2; Mar. 18, 2008) (“Matsuura”). *See* Final Act. 7–18, 23–26.

Claims 55, 58–61, 63, 71, 72, 74–77, and 89 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sharma and Matsuura. *See* Final Act. 19–23.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellants’ arguments in the Brief and the Answer. We are not persuaded of error by Appellants’ arguments. We agree with and adopt as our own the Examiner’s findings and conclusions of law. We highlight and address specific findings and arguments below for emphasis.

Double Patenting

The Examiner rejected claims 1, 3, 4, 8–11, 13–16, 18, 19, 22–26, 28–31, 33, 34, 38–41, 43–47, 49, 50, 53, 55, 58–61, 63, 66–69, 71, 72, 74–77, and 79–93 under the non-statutory doctrine of obviousness-type double patenting as unpatentable over Application 12/647,749, now US 8,626,845 B2. *See* Final Act. 2–6. Appellants do not present arguments addressing the double patenting rejection. *See* Br. 13–19; Ans. 3. Under our procedural rules, an appeal is presumed to be taken from the rejection of all of the claims under rejection unless cancelled by an entered amendment. *See* 37 C.F.R. § 41.31(c). Therefore, we sustain *pro forma* the rejection of claims 1, 3, 4, 8–11, 13–16, 18, 19, 22–26, 28–31, 33, 34, 38–41, 43–47, 49,

50, 53, 55, 58–61, 63, 66–69, 71, 72, 74–77, and 79–93 under the non-statutory doctrine of obviousness-type double patenting as unpatentable over Application 12/647,749, now US 8,626,845 B2, because Appellants do not present any argument addressing this rejection.

Obviousness – Claims 1, 3, 4, 8–11, 13–16, 18, 19, 22–26, 28–31, 33, 34, 38–41, 43–47, 49, 50, 53, 69, 66–69, 79–88, and 90–96

Appellants argue that Sharma does not teach “the content request includes at least one keyword, and generating the content for the opened electronic communication includes extracting the at least one keyword from the content request, and obtaining the content for the opened electronic communication based on the at least one keyword,” as recited in claims 1 and 31, and recited similarly in claim 16. *See* Br. 14–15. Appellants contend “the present invention is directed to obtaining content in accordance with the at least one keyword, where the content [is] provided over [a] network to the center of the content request.” *Id.* at 15. Appellants argue “[t]he ‘converting’ of claims 1 and 3[1] and the ‘responding’ of claim 16 [are] performed not on the machine that requests the content, but on another machine communicated to over a network.” *Id.* Appellants assert that Sharma teaches a modification program that sits on top of an existing e-mail client in which “two images form a single image when displayed a[t] the recipient (opened) e-mail message.” *Id.* at 14. Appellants emphasize that in Sharma the modifications are performed at the client. *See id.* at 14–15.

We are not persuaded by Appellants’ argument because, as pointed out by the Examiner (*see* Ans. 4), Appellants’ arguments are not commensurate in scope with the claim limitations. As the Examiner finds (*see id.*), claims 1, 16, and 31 do not recite that the generating, obtaining,

and converting of content requires the content to be performed at another device and provided over a network. Appellants also do not direct us to claim language that precludes the generating, obtaining, and converting of content to be performed at an e-mail client.

Appellants further argue that Sharma does not teach or suggest “converting the content into an image associated with the content,” as recited in claims 1, 16, and 31. *See* Br. 15. Appellants contend that Sharma instead “utilizes a banner server . . . that fetches a stored prerendered image of a selected advertisement, and sends this prerendered image, in the form of a graphic, from storage to the recipient’s computer,” where it is “displayed (as a banner 22) in an e-mail message field image 20b of the recipient’s e-mail.” *Id.* (citing Sharma ¶ 43, Fig. 4).

We are not persuaded by Appellants’ argument because, as pointed out by the Examiner (*see* Ans. 5), the Examiner relies on Matsuura for teaching or suggesting the disputed limitation. For these same reasons we are not persuaded by Appellants’ argument that Tucciarone does not teach the disputed limitations. *See* Br. 16–17.

Related to the previous argument, Appellants argue that Matsuura also does not teach or suggest “converting the content into an image associated with the content,” as recited in claims 1, 16, and 31, and recited similarly in independent claims 45 and 94. *See* Br. 15–17. Appellants argue that Matsuura does not teach that the converting is performed in accordance with at least one keyword. *See id.* at 16–17. Appellants assert that Matsuura teaches converting portions of an e-mail into a web format, in accordance with the capabilities of the device on which the images are to be displayed. *See id.* Appellants also argue that there would be no motivation to combine

Matsuura with Sharma and Tucciarone because Sharma is directed to a client based solution for combining images on a device, and content identifiers and keywords are not communicated to a server to retrieve the images to be displayed. *See id.* at 16.

Appellants' arguments are not persuasive because, as pointed out by the Examiner (*see* Ans. 12) they are not commensurate in scope with the claim limitations. As explained by the Examiner, the claims do not recite that the "converting" is performed in accordance with at least one keyword. *See id.* Appellants' arguments regarding motivation to combine also are not commensurate in scope with the limitations of claims 1, 16, 31, 45, and 94 because these claims do not require communication to a server, nor preclude a client based solution.

Lastly, we find no support in the record for Appellants' arguments regarding motivation to combine. It is well settled that mere attorney argument, unsupported by factual evidence, is entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (attorney argument is not evidence). Appellants do not address sufficiently the Examiner's articulated reasoning for combining the teachings of Sharma, Tucciarone, and Matsuura—"for providing time relevant content into electronic communications as disclosed by Sharma in order to make the content provisioning into an electronic communication more robust and reliable," and "for providing time relevant content into electronic communications as disclosed by Sharma and Matsuura in order to streamline the advertising functionality from the perspective of multiple advertisers resulting in an improved business model for providing advertise[ment]s to the consumer."

Final Act. 9–10. Accordingly, we are not persuaded of error in the Examiner’s rationale for combining the references.

Regarding independent claims 45 and 94, Appellants argue that Tucciarone does not teach or suggest “obtaining content associated with content providers for the at least one keyword in an order based on a predetermined priority of the content providers at the time the content is obtained,” as recited in claim 45, and “generating content for the opened electronic communication by applying at least one predetermined rule or policy to the content request at the time the content request is received,” as recited in claim 94. *See* Br. 17. Appellants contend that the Examiner’s citation to paragraphs 19 and 20 of Tucciarone do not mention that the eMessaging delivered offerings are in any kind of priority order at the time the content is arranged. *See id.*

We are not persuaded by Appellants’ arguments. As the Examiner finds, Tucciarone teaches that advertisers, under certain agreed-upon procedures, may post their most current advertising messages in the primary e-mail interface. The Examiner further finds, and we agree, the foregoing description in Tucciarone teaches or suggests an order based on a predetermined priority of the content providers at the time the content is obtained, and applying at least one predetermined rule or policy to the content request at the time the content request is received, as recited in Appellants’ claims. *See* Final Act. 24–25 (citing Tucciarone ¶¶ 19–20); Ans. 7, 10 (citing Tucciarone ¶¶ 19–20). We also agree with the Examiner’s additional findings that the application of rules policy and the prioritization of one content provider over another is taught or suggested by steps 18 and 19G of Tucciarone’s Table A. Ans. 11 (citing Tucciarone Table A (p. 18)).

Appellants further contend that independent claims 66 and 82 recite similar features to those of claims 1, 16, and 31, and the Examiner's rejections are erroneous for the same reasons as claims 1, 16, and 31. *See* Br. 17–18. Appellants do not present substantive arguments addressing dependent claims 3, 4, 8–11, 13–15, 18, 19, 22–26, 28–30, 33, 34, 38–41, 43, 44, 46, 47, 49, 50, 53, 67–69, 79–81, 83–88, and 95–96. *See id.* at 18. Accordingly, for all of the foregoing reasons, Appellants do not persuade us of error in the Examiner's determination that claims 1, 3, 4, 8–11, 13–16, 18, 19, 22–26, 28–31, 33, 34, 38–41, 43–47, 49, 50, 53, 69, 66–69, 79–88, and 90–96 are unpatentable over Sharma, Tucciarone, and Matsuura.

Obviousness – Claims 55, 58–61, 63, 71, 72, 74–77, and 89–93

Appellants contend that the references do not teach or suggest, “an imaging server in data communication with the first server configured for providing the content for the electronic communications by: converting the content into an image associated with the content . . . ,” as recited in independent claim 55, and recited similarly in independent claim 71. *See* Br. 18. Appellants contend that Sharma fails to teach or suggest any server configured for converting the content into an image associated with the content. *See id.* Appellants further argue that since Sharma uses prerendered images the claimed imaging server is not needed. *See id.* Appellants argue that Matsuura does not teach or suggest that the “converting” is performed in accordance with at least one keyword. *See id.*

Appellants' arguments are not persuasive because, as pointed out by the Examiner (*see* Ans. 16–17), the Examiner relies on Matsuura for teaching or suggesting the disputed limitations, not Sharma. *See* Final Act. 21. Appellant's argument that Matsuura does not teach or suggest the

converting is performed in accordance with at least one keyword is not persuasive because it is not commensurate in scope with the claim limitations. Claims 55 and 71 do not recite that the converting step is performed in accordance with at least one keyword. Appellants' arguments addressing the teachings of Tucciarone (*see* Br. 18) are not applicable to the rejection of claims 55 and 71 because the Examiner's rejection is based on the teachings of Sharma and Matsuura. *See* Final Act. 19–22.

For all these reasons, Appellants do not persuader us of error in the Examiner's rejection of claims 55 and 71 as unpatentable over Sharma and Matsuura. Appellants do not present separate substantive arguments addressing dependent claims 58–61, 63, 72, 74–77, and 89–93. *See* Br. 19. Accordingly, for the same reasons as claims 55 and 71, Appellants do not persuade us of error in the Examiner's rejection of claims 58–61, 63, 72, 74–77, and 89–93 are unpatentable over Sharma and Matsuura.

DECISION

We AFFIRM the rejections of claims 1, 3, 4, 8–11, 13–16, 18, 19, 22–26, 28–31, 33, 34, 38–41, 43–47, 49, 50, 53, 55, 58–61, 63, 66–69, 71, 72, 74–77, and 79–96.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED